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| 09/863,921      | 05/23/2001  | Parul A. Mittal      | JP920010008US1      | 1619             |

7590 09/13/2004  
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| EXAMINER |
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YOUNG, JOHN L

| ART UNIT | PAPER NUMBER |
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3622

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/863,921

Applicant(s)

MITTAL ET AL.

Examiner

John L Young

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*[Signature]*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received

JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/7/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **NON-FINAL REJECTION**

### **DRAWINGS**

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

### **CLAIM OBJECTION**

2. Claim 35 is objected to because of a typographical error. Claim 35 at line 1, after the word "The" first occurrence, delete the word "method" and replace it with the word – apparatus--.

3. Claim 26 is objected to as being indefinite because the preamble of claim 26 does not relate to the body of the claim, i.e., the preamble discusses classifying a sample in predetermined classes; and the body of the claim recites promotional offer elements and limitations.

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### CLAIM REJECTIONS — 35 U.S.C. §101

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process,  
machine, manufacture, or composition of matter or any new and  
useful improvement thereof, may obtain a patent therefore, subject  
to the conditions and requirements of this title.

4. Claims 1-16 & 19-25, are rejected under 35 U.S.C. 101, because said claim is directed to non-statutory subject matter.

As per claims 1-16 & 19-25, as drafted said claims are not limited by language within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b), even though said claims are limited by language to a useful, concrete and tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75, 47 USPQ 2d at 1602 (Fed Cir. 1998); *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999).

Note: it is well settled in the law that “[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527

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F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims." (See MPEP 2173.05( q )).

**CLAIM REJECTION — 35 U.S.C. §103( a )**

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-47 are rejected under 35 U.S.C. §103(a) as being unpatentable over Herz US 2001/0014868 (08/16/2001) [US f/d: 07/22/1998] (herein referred to as "Herz").

As per claim 1, Herz (the ABSTRACT; FIG. 1; FIG. 4; FIG. 5B;

¶¶[0002]; [0016]; [0020]; [0266]; and [0271]) shows "A method of conducting a

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promotional offer, the method comprising steps of . . . targeting one or more of a plurality of customers as recipients of the offer. . . .”

Herz (the ABSTRACT; FIG. 4; ¶¶[0019]; [0032]; [0052]; [0141]; [0167]; [0190]; [0194]; [0206]; [0215]; [0219]; [0246]; [0249]; and [0294]) implicitly shows: “defining the structure of a promotional offer having a plurality of associated parameters, one or more of which are unspecified or can be varied . . . wherein one or more of the unspecified or variable parameters associated with the offer are individually assigned for one or more of the targeted customers to whom the record of the offer is distributed.”

Herz (¶[0038]) discloses: “*the coupon may serve to remind the shopper of the offer.*” In this case, the Examiner interprets this disclosure as showing “distributing a record of the offer to the customers. . . .” (i.e., where the “*coupon*” is the “record”).

Herz (¶¶[0038]; [0132]; [0133]; [0152]; [0192]; [0193]; and [0198]) implicitly shows “distributing a record of the offer to the customers. . . .”

Herz lacks explicit recitation of “distributing a record of the offer to the customers. . . .” even though Herz (¶[0038]; FIG. 5A; ¶¶ [0132]; [0133]; [0152]; [0192]; [0193]; and [0198]) implicitly shows implicitly shows same.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure Herz (¶[0038]; FIG. 5A; ¶¶ [0132]; [0133]; [0152]; [0192]; [0193]; and [0198]) implicitly shows “distributing

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a record of the offer to the customers. . . .”; and it would have been obvious to modify and interpret the disclosure of Herz cited above as showing “distributing a record of the offer to the customers. . . .”, because modification and interpretation of the cited disclosure of Herz would have provided a “*system [that] automatically constructs product offers tailored to individual shoppers, or types of shoppers. . . .*” (see Herz ¶[0004]), based on the motivation to modify Herz “*in a way that attempts to maximize the vendor’s profits.*” (See Herz ¶[0004]).

As per dependent claims 2-21, Herz shows the method of claim 1 and subsequent base claims depending from claim 1.

Herz (the ABSTRACT; FIG. 1; FIG. 4; FIG. 5B; ¶¶[0002]; [0016]; [0019]; [0020]; [0032]; [0052]; [0141]; [0167]; [0190]; [0194]; [0206]; [0215]; [0219]; [0246]; [0249]; [0266]; [0271]; and [0294]) implicitly shows all of the elements and limitations of claims 2-21; however,

Herz lacks explicit recitation of some of the elements and limitations of claims 2-21; therefore,

Official Notice is taken that both the concepts and the advantages of those elements and limitations of dependent claims 2-21 not shown by Herz were notoriously well known and expected in the art at the time of the invention, because it would have been obvious at the time the invention was made to a person

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having ordinary skill in the art that the disclosure of Herz cited above combined with the knowledge of one skilled in the art implicitly shows those elements and limitations of claims 2-21 which are not explicitly recited in Herz; and it would have been obvious to modify and interpret the disclosure of Herz cited above as showing all of the elements and limitations of claims 2-21, because modification and interpretation of the cited disclosure of Herz would have provided a “*system [that] automatically constructs product offers tailored to individual shoppers, or types of shoppers. . . .*” (see Herz ¶[0004]), based on the motivation to modify Herz “*in a way that attempts to maximize the vendor’s profits.*” (See Herz ¶[0004]).

Independent claim 22 is rejected for substantially the same reasons as independent claim 1.

Independent claim 23 is rejected for substantially the same reasons as independent claim 1.

Independent claim 24 is rejected for substantially the same reasons as independent claim 1.



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Independent claim 25 is rejected for substantially the same reasons as independent claim 1.

Independent claim 26 is rejected for substantially the same reasons as independent claim 1.

Independent claim 27 is rejected for substantially the same reasons as independent claim 1.

As per dependent claims 28-47, Herz shows the apparatus of claim 27 and subsequent base claims depending from claim 27.

Herz (the ABSTRACT; FIG. 1; FIG. 4; FIG. 5B; ¶¶[0002]; [0016]; [0019]; [0020]; [0032]; [0052]; [0141]; [0167]; [0190]; [0194]; [0206]; [0215]; [0219]; [0246]; [0249]; [0266]; [0271]; and [0294]) implicitly shows all of the elements and limitations of claims 28-47; however,

Herz lacks explicit recitation of some of the elements and limitations of claims 28-47; therefore,

Official Notice is taken that both the concepts and the advantages of those elements and limitations of dependent claims 28-47 not shown by Herz were notoriously well known and expected in the art at the time of the invention, because it would have been obvious at the time the invention was made to a person

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having ordinary skill in the art that the disclosure of Herz cited above combined with the knowledge of one skilled in the art implicitly shows those elements and limitations of claims 28-47 which are not explicitly recited in Herz; and it would have been obvious to modify and interpret the disclosure of Herz cited above as showing all of the elements and limitations of claims 28-47, because modification and interpretation of the cited disclosure of Herz would have provided a “*system [that] automatically constructs product offers tailored to individual shoppers, or types of shoppers. . . .*” (see Herz ¶[0004]), based on the motivation to modify Herz “*in a way that attempts to maximize the vendor’s profits.*”

(See Herz ¶[0004]).

### CONCLUSION

6. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

(703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

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Seventh floor Receptionist  
Crystal Park V  
2451 Crystal Drive  
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

John L. Young

JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER

Primary Patent Examiner

August 19, 2004